code in the box entitled "Residence". The requirement, in 37 CFR 1.63(a)(3), is only that this information be included or supplied. See also M.P.E.P. 605.02. It does not specify where in the Declaration, and it does not specify that it must be in any particular box. Therefore, because this requisite information is supplied in the Declaration in accordance with the provisions of 37 CFR 1.63(a)(3), Applicants respectfully request that the Examiner's objection be withdrawn.

In addition, the Examiner states that the present application names joint inventors. Applicants note that the inventor of the present application is a sole inventor.

II. Rejection under 35 U.S.C. §112, second paragraph

The Examiner has rejected Claims 1 to 9, 15 and 16 under 35 U.S.C. §112, second paragraph, for being indefinite. Specifically, the Examiner finds it is unclear how many components are in Claim 1. Applicants amend Claim 1, to clarify that there are two components designated by a) and b). The first component "a)" is the polymeric component which can be a number of different polymers, and the second component "b)" is the water soluble organic pigment. No new matter is added.

III. Water Soluble Organic Pigments Are Not Disclosed by the Cited References

The present invention is the combination of a water soluble organic pigment with a polymeric component that is an acrylic acid derived polymer, or a methacrylic acid ester derived polymer. In the present Office Action, the Examiner asserts that each of the patents issued to Alwattari et al. (U.S. Pat. No. 5,874,072, hereinafter referred to as "the '072 reference") and to Remz et al. (U.S. Pat. No. 4,712,571, hereinafter referred to as "the '571 reference") anticipates the present invention because its disclosure is not limited to water-insoluble lakes. According to the Examiner, all disclosures in a reference must be evaluated, including non-preferred embodiments. However, Applicants maintain that even upon review of each of the cited references in its entirety, they each fail to disclose water soluble organic pigments.

Although, a reference (or its claims) is not limited to the disclosure of the working examples (or any other disclosure in the specification), the specification, including the working examples, provides guidance as to how terms are to be interpreted. *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 867, 228 USPQ 90, 93 (Fed. Cir. 1985); *SRI International v. Matsushita Elec. Corp. of America*, 775 F.2d 1107, 1121, 227 USPQ 577, 585 (Fed. Cir. 1985) (en banc). Anticipation requires that every element of the invention must be literally present, arranged as in the claims. *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 894 n.5, 221 USPQ 669,

674 n.5 (Fed. Cir.), *cert. denied,* 469 U.S. 857, 225 USPQ 792 (1984). In the present case, upon evaluating the cited references as a whole, their disclosures indicate that the term "pigment" is to be interpreted as water insoluble lakes. The cited references make no mention of water soluble pigments, expressly or inherently. Therefore, the cited references fail to disclose water soluble organic pigments and they fail to anticipate the present invention.

A. The '072 Reference

Claims 1 to 4, 6 to 13, 15, 17, and 19 to 21 are considered by the Examiner to be anticipated by the '072 reference because the Examiner believes that the D&C organic pigments disclosed in this reference are water-soluble. However, there are several consistent disclosures throughout the '072 reference which indicate that the term "pigments" means water insoluble pigments. The first is found in column 6, line 8, where it states that the pigment includes organic lake pigments, in addition to the inorganic pigments and the pearlescent pigments. All of these are water insoluble pigments. No mention is made of any other type of organic pigments. The second is found in the description of pearlescent pigments after specific organic pigments and lakes are provided. As described at column 6, line 37 to 38, pearlescent pigments can be combined with the organic pigments of the above-mentioned type. That type is the organic lake pigment – which is water insoluble. Water soluble pigments are not mentioned.

The third piece of evidence in support of the water insoluble pigments as the meaning of pigment in the '072 reference is found in the Processing Directions at column 7, lines 5 to 49. Each set of directions demonstrates that the pigment is water insoluble. In "1. Oil-in-Water Emulsion," at column 7, line 12, pigments are added along with any *oil* dispersible or *oil* soluble components. One of ordinary skill in the art would find it illogical to combine a water soluble organic pigment with oil dispersible and oil soluble components, especially since there is an aqueous component that is more suitable for a water soluble pigment. There is no disclosure in the '072 reference that its pigments are to be added to the aqueous component, and this omission indicates that pigments in the '072 reference are not water soluble.

The processing directions for "2. Water-in-Oil Emulsions" further illustrates that water soluble pigments are not disclosed by the '072 reference. At column 7, lines 39 to 40, the directions are to disperse pigments and *any other hydrophobic materials* together with the lipophilic material. From this, one can infer that the pigments of the '072 reference are hydrophobic materials, i.e., water insoluble. Thus, upon evaluating the '072 reference as a whole, the reasonable interpretation of the term "pigments" is that they are water insoluble. The authors

of the '072 reference did not disclose water-soluble organic pigments, and therefore, the '072 reference does not anticipate the present invention. Anticipation occurs if all of the elements of the claim, considering the claim as a whole, are found within a single prior art reference. *RCA Corp. v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 387-388 (Fed. Cir.), cert. den., 468 U.S. 1228, (1984).

Because the '072 reference does not inherently or expressly disclose the water soluble organic pigments of the present invention, anticipation cannot be found. Accordingly, Applicants request that the rejection under 35 U.S.C. §102(b) be withdrawn.

B. The '571 Reference

Claims 1 to 4, 6 to 13, 15, 17 and 19 to 21 are considered by the Examiner to be anticipated by the '571 reference. As previously mentioned above, the compositions of the present invention comprise an acrylic or methacrylic acid derived polymeric or copolymeric component in combination with at least one water soluble organic pigment. According to the Examiner, the '571 reference discloses FD&C yellow 5, and therefore discloses a water soluble pigment. A list of pigments, at column 2, lines 33 to 35, of the '571 reference, refers to FDA certified pigments including FD&C Yellow 5. However, upon evaluating the '571 reference in its entirety, it can be seen, as one of ordinary skill in the art would see, that the pigments in the '571 reference are water insoluble lakes. As mentioned in Applicants' response of June 15, 2000, lakes are, pursuant to 21 C.F.R. 82.51, made by extending a salt on a substrate, and are insoluble pigments, unlike water-soluble organic pigments.

The '571 reference is replete with references to water insoluble pigments. Specifically, the list of pigments mentioned above, and relied upon by the Examiner, is surrounded by elaborations to water insoluble pigments. In stark contrast, no mention is made of water soluble pigments. For example, at column 2, lines 44 to 48, immediately following the list of pigments, the '571 reference discloses that the amount of pigment used depends on the *oil* absorbing properties of the pigment chosen. Thus, the pigment of the '571 reference is not water soluble. Further, as previously mentioned by Applicants in their response of June 15, 2000, at column 2, lines 18 to 27, immediately before the list of pigments, the suitable pigments are described as being substantially insoluble in solvents, essentially free from a tendency to bleed, and having an average particle size such that satisfactory dispersing is insured. These characteristics are clearly that of a water insoluble pigment.

As explained in the present specification at page 1, lines 26 to 28, most organic pigments have a tendency to bleed or fade. In addition, the water soluble organic pigments of the present invention are solubilized, and therefore, particle size measurements of the water soluble pigment are lower than the detectable limit of analytical instrumentation. In contrast, the pigments of the '571 reference have a particle size of 0.1 to 2.0 microns, and therefore, are not water soluble, as disclosed at column 2, lines 24 to 27. As also mentioned in the present specification at page 2, lines 5 to 7, the use of acrylic polymers with inorganic pigments causes applicators to clog. One remedy to this problem is to lower the amount of inorganic pigments. The '571 reference, however, points out at column 1, line 48 to 56, that reducing the pigment or other solids content renders an unsatisfactory composition. The '571 reference attempts to solve this problem by grinding a mill base with the pigment to reduce the particle size of the pigment. In addition, the '571 reference, at column 11, lines 9 to 12, discloses that suspending agents aid in suspending pigments. "In the absence of such agents, pigments tend to settle in a dense hard pack." If the '571 pigment was water soluble the formation of hard densely packed pigments would be no risk at all or nearly so.

Applicants also previously indicated evidence throughout the '571 reference to demonstrate that the pigments of the '571 reference are not water soluble. For example, in Examples 1 to 12, and Table 3, the '571 reference only discloses lakes consistent with the other previously mentioned disclosures regarding pigments. In addition, the formulations in Tables 1 and 2 are directed to forming pigment chips which are, like the particles, inherently not water soluble because they maintain an even greater particle size. Therefore, all of the Examples and Tables of the '571 reference incorporate insoluble pigments, and the water soluble organic pigments of the present invention are not disclosed. Under 35 U.S.C. § 102, a sufficient description of the claimed invention must be stated in a reference to place it in the possession of the public. *Paperless Accounting, Inc. v. Bay Area Rapid Transit System*, 231 USPQ 649, 653 (CAFC 1986)(citations omitted).

Because the '571 reference only discloses insoluble pigments and lacks any mention of water soluble organic pigments, the '571 reference does not place the present invention in the possession of the public, and the present invention is not anticipated by the '571 reference. Applicants, therefore, request that the rejection under 35 U.S.C. §102(b) be withdrawn.

IV. Unobviousness

The Examiner rejects the claims of the present invention for being obvious. With respect to the obviousness rejection, Applicants believe that none of the cited references alone or in combination teach or suggest the present invention because they do not teach or suggest the combination of a water-soluble organic pigment with an acrylic or methacrylic polymer. Further, the cited references and the general knowledge of one of ordinary skill in the art do not provide motivation to combine the cited references to make the present invention or achieve its beneficial results.

In order to establish a *prima facie* case of obviousness, it is necessary for the Examiner to present evidence, preferably in the form of some teaching, suggestion, incentive or inference in the cited prior art, or in the form of generally available knowledge, that one of ordinary skill in the art would have been led to combine the relevant teachings of the cited references in the manner proposed by the Examiner to arrive at the claimed invention. *Ex parte Levengood*, (BdPatApp&Int 1993) 28 USPQ2d 1300, 1301. If the only suggestion for the Examiner's combination of the isolated teachings of the applied references is derived from Applicant's disclosure, and not from the applied prior art, rejection based on obviousness is improper. *In re Ehrreich*, 590 F.2d 902, 200 USPQ 504 (CCPA 1979).

A. The '072 and the '277 References

The Examiner cites the '072 reference and the '277 reference against Claims 1 to 21 under 35 U.S.C. §103(a). While noting that the '072 reference does not teach a flow-through eyeliner pen having a nib, the Examiner asserts that one of ordinary skill in the art would prepare the composition of the '072 reference, using the flow-through pen with nib taught by the '277 reference. The Examiner finds motivation in the desire to apply cosmetics with ease. Before addressing the substance of this rejection, Applicants note that Claims 1 to 14, and 19 to 21 do not describe a flow-through eyeliner pen having a nib. However, for reasons stated below, the '072 reference does not render these claims obvious. As it pertains to the combination of references, Applicants address their response to Claims 15 to 18.

The '072 reference fails to render Claims 1 to 21, and specifically, Claims 1 to 14, and 19 to 21, obvious. As previously discussed above with respect to the Examiner's novelty rejection based on this reference, the '072 reference fails to teach or suggest a water soluble organic pigment. The '277 reference discloses, at column 1, lines 58 to 62, water-soluble organic pigments. However, because the '277 reference fails to teach or suggest the polymeric component of the present invention, it alone fails to disclose the present invention.

In combination with the '072 reference, the '277 reference still fails to teach or suggest the present invention because there is no motivation to incorporate the water-soluble pigments of the '277 reference in the '072 reference. One of ordinary skill in the art would not expect water-soluble organic pigments to be protected in the compositions of the '072 reference. Waxes, oils and fats, and pigments are an optional part of the '072 compositions, as they are described in the specification at columns 5 and 6. However, in the '277 reference, at column 1, lines 22 to 31, the disadvantages of waxes, and oils, are extolled. Some of the particular disadvantages mentioned include clogging and lack of ability to hold the lipline when lip color is applied. Therefore, ease of application would not be expected, and motivation to combine these two references is not found in the references themselves. In fact, the '277 reference teaches away from such a combination. There is no suggestion to combine if a reference teaches away from its combination with another source. *Tec Air Inc. v. Denso Manufacturing Michigan Inc.*, 52 USPQ2d 1294, 1298 (CAFC 1999)(citing *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1599 (Fed. Cir. 1988)).

Because there is no motivation to combine the '072 and the '277 references, Applicants submit that the claims of the present application satisfy the requirements of 35 U.S.C. §103(a).

B. The '277, the '072 and the '571 References

First, the Examiner asserts that the combination of the '072 reference and the '571 reference renders Claims 1 to 15, 17, and 19 to 21 unpatentable under 35 U.S.C. §103(a). In particular, according to the Examiner, it would have been obvious to one of ordinary skill in the art to follow the teachings of either reference and combine it with the teachings of the other because of the desire to improve the wear and ease of applying cosmetics. Second, the Examiner also rejects Claims 16, 18 and 22 as being obvious in light of the '072 reference in combination with the '571 reference and further in view of the '277 reference. However, with respect to each rejection, the Examiner fails to indicate where in these references or in the general knowledge, one of ordinary skill in the art would find motivation to combine the references.

With respect to the '571 reference and the '072 reference, Applicants discussed above with respect to the Examiner's novelty rejection, why these references each fail to teach or suggest a water soluble organic pigment, and therefore, the combination of the references, does not remedy the lack of water soluble organic pigments. The combination of the '277 reference with these cited references, likewise, does not render the present invention obvious.

The Examiner cites *In re Crockett* ("*Crockett*") in support of the premise that the idea of combining the '072, the '571, and the '277 compositions flows logically from their having been

taught in the prior art. However, Applicants assert that this is not the requirement for combining references, and the basis for this premise is inaccurate. In *Crockett*, each of two references at issue taught that different individual components performed the same function. Therefore, it logically flowed that a composition containing each of the components together would result in an additive or increased effect in that function. However, the circumstances in *Crockett* do not apply to the present application. Unlike *Crockett*, none of the references cited against the present invention teaches or suggests the beneficial results of interchanging the water insoluble pigment with the water-soluble pigment in combination with the acrylic or methacrylic derived polymer. Current caselaw is clear that the best defense against a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (CAFC 1999) (citations omitted).

One of ordinary skill in the art would not be motivated to substitute the water insoluble pigments of the '072 and the '571 references with water soluble pigments of the '277 reference. At one end of the spectrum, the '072 reference teaches an acrylic polymer containing water insoluble pigments. Similar to the '072 reference, the '571 reference teaches a water insoluble pigment in a water insoluble protective colloid. At the other end of the spectrum, the '277 reference teaches the use of a water-soluble organic pigment in a water based system. However, none of the cited references addresses the middle ground, particularly, the water-soluble organic pigment in an acrylic polymer based system. Like oil and water do not mix, one of ordinary skill in the art would not expect water soluble pigments in anything but water to mix. In other words, one of ordinary skill in the art would not expect the water-soluble organic pigment to be functional unless it was in a water based system. Nor would they expect the surprising benefits found with the present invention, namely, protecting the water soluble pigments from running and fading. The combinations of pigments and bases taught in the cited references do not defy logic.

In an opinion rendered in *Gillette Co. v. S.C. Johnson & Son Inc.*, 16 USPQ2d 1923 (CAFC 1990), it was found that water soluble ingredients are not interchangeable with oil soluble ingredients in an obviousness analysis. In *Gillette*, the gel of the invention at issue used a water-soluble gelling agent while the prior art used an oil-soluble "jellifying" agent. The court in *Gillette*, decided that the results achieved by the new combination, using the water-soluble agent and not the oil-soluble agent, were critical to the analysis of obviousness, and it was determined that the two agents were not interchangeable. As in *Gillette*, the water-soluble pigments of the present invention and the water insoluble pigments of the cited prior art are not interchangeable

and one of ordinary skill in the art would not expect them to be interchangeable. Before concluding, the opinion in *Gillette* states "The invention all admired, . . . ; so easy it seemed, once found, which yet unfound most would have thought, impossible!" *Id.* at 1929. Likewise, the present invention and the benefits derived therefrom are not taught or suggested by any of the cited references.

Because no motivation or desire is found in the cited references, or in the general knowledge, to modify any of the cited references to make the present invention, a *prima facie* case of obviousness has not been made, and Applicants request that the rejection under 35 U.S.C. §103(a) be withdrawn.

CONCLUSION

Accordingly, the claims, as amended, are believed to be in condition for allowance, and issuance of a Notice of Allowance is respectfully solicited.

Respectfully submitted,

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Estelle J. Tsevdos, Reg. No. 31,145
Kenyon & Kenyon
One Broadway
New York, NY 10004
(212) 425-7200